UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WOLFGANG MAUS

Appeal No. 2005-1520
Application No. 09/632,248

ON BRIEF

Before WARREN, WALTZ and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 6-15, 18, 19, 21 and 22, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a honeycomb element and an associated insulating mat and swelling mat and a catalytic exhaust gas purification device comprising such. An understanding of the invention can be derived from a reading of exemplary claims 1 and 12, which are reproduced below.

1. A catalytic exhaust-gas purification device, comprising:

a casing;

a monolithic ceramic honeycomb element mounted in said casing;

a compensating layer disposed between said casing and said honeycomb element and wound around said honeycomb element, said compensating layer including:

a swelling mat with border regions at risk from abrasion;

an insulating mat having a border and an inner region;

said border of said insulating mat having a thicker region at least at one end of said honeycomb element than at said inner region; and

said swelling mat being disposed adjacent a side of said inner region of said insulating mat facing away from said honeycomb element and said thicker region of said border of said insulating mat covering said border regions of said swelling mat at risk from abrasion.

12. In combination with a honeycomb element, a compensating layer to be wound around the honeycomb element, comprising:

an insulating mat with a border and an inner region, said inner region having a given thickness and said border of said insulating mat being thicker than said inner region at least in parts thereof; and

a swelling mat with border regions at risk from abrasion, said swelling mat being disposed adjacent said inner region of said insulating mat with said thicker parts of said border covers said border regions of said swelling mat at risk from abrasion.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Santiago et al. (Santiago)	4,344,922	Aug. 17, 1982
Eyck	4,999,168	Mar. 12, 1991

Locker et al. (Locker) 6,077,483 Jun. 20, 2000
(Filed Jun. 03, 1998)

Claims 1-3, 7, 8, 12-15 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Locker.[1] Claims 6 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Locker in view of Eyck. Claims 9-11, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Locker in view of Santiago and Eyck.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

§ 102 rejection.

The examiner has the initial burden of establishing a prima facie case of anticipation by pointing out where all of the claim limitations appear in a single reference. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990);

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[1]Also, Locker appears to be available as prior art under § 102(a).

In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). The reference must lead one of ordinary skill in the art to subject matter which falls within the scope of the claims "without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference" In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

All of the claims on appeal require a honeycomb element, an insulating mat and a swelling mat. The insulating mat includes an inner region that is not as thick, at least in part, than a thicker region located at a border region of the insulating mat. The border regions of the swelling mat are said to be at risk from abrasion and the swelling mat is disposed in a manner adjacent to the inner region of the insulating mat such that the thicker region of the insulating mat border covers "at risk" border regions of the swelling mat.

Appellant does not dispute the examiner's determination that Locker describes a catalytic converter with a honeycomb element and a swelling mat corresponding to appellant's claimed honeycomb element and swelling mat.

The examiner has taken the position that a barrier coating insulation layer (12) that has a thicker region (12A) corresponds

to the claimed insulation mat and is disposed in a relationship to the swelling mat (14) and honeycomb element (10) of Locker in a manner that is embraced by appelllant's appealed claims 1-3, 7, 8, 12-15 and 19. See, e.g., pages 3 and 4 of the answer and the portions of the specification and drawings of Locker referred to by the examiner.

However, appellant disagrees. In this regard, appellant asserts that the insulative coating layer (12) of Locker does not represent a "mat" as here claimed. See, e.g., pages 5-9 of the brief.

As our initial inquiry into a review of the examiner's anticipation rejection, we must analyze the claim language to determine the scope and meaning of such a contested limitation. See Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). During prosecution of a patent application, the terms in a claim are given their broadest reasonable interpretation consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Although no limitations in the specification is normally imputed to the claims being interpreted, see In re Paulsen, 30 F.3d at 1480, 31 USPQ2d at 1674, the specification can still be

used to impart the meaning of words in the claims, see In re Barr, 444 F.2d 588, 593, 170 USPQ 330, 335 (CCPA 1971).

A review of appellant's specification reveals that a definition for the contested insulating "mat" term is not furnished therein so as to give any special meaning to that term. At page 6 of the brief, appellant refers to a Merriam-Webster online dictionary (copy not attached to the brief) in maintaining that the contested "mat" term "generally means a piece of coarse, woven, plaited, or felted fabric." That definition of the term is consistent with one definition of mat found at page 716 of Merriam-Webster's Collegiate Dictionary, Tenth Edition.[2]

In some environments, as recognized by the examiner, a slab of reinforced concrete may constitute a mat.[3] In this regard, we note that appellant's invention expressly encompasses an embodiment wherein the compensating layer can be assembled from preshaped segments (see appellant's drawing figures 3 -5 and appealed dependent claims 9-11). In our view, one of ordinary

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[2] See definition 1 a (1) of mat at page 716 and the definition of fabric at page 415 of Merriam-Webster's Collegiate Dictionary, Tenth Edition (1996). A copy is attached to the decision.

[3] See defintion 3 of mat at page 716 of Merriam-Webster's Collegiate Dictionary, Tenth Edition (1996).

feature offered by the examiner in advancing the § 102(b) rejection discussed above.

Concerning this matter, we note that neither the examiner in the answer or appellant in the brief have addressed Locker's teachings about the alternative additives that can be used in an insulation coating. In this regard, Locker teaches that the insulation coating may comprise a selected additive material, including fiber additives. See column 4, lines 54-65 of Locker. We note that selecting the alternative of adding fibers to the insulation barrier coating of Locker as suggested therein would appear to have reasonably resulted in the formation of a mat layer; that is, a fiber containing layer surrounding the honeycomb structure of the catalyst. While picking and choosing from among numerous alternatives may have no place in making a § 102 rejection for anticipation, such can be entirely proper in making an obviousness rejection under § 103. See In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Remand

In light of the above, we remand this application to the examiner for further consideration of the § 103(a) rejections and to determine whether or not a § 103(a) rejection of any of appellant's claims (including the independent claims) over Locker

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Remand

In light of the above, we remand this application to the examiner for further consideration of the § 103(a) rejections and to determine whether or not a § 103(a) rejection of any of appellant's claims (including the independent claims) over Locker with/without the other prior art of record is appropriate based on the suggestion in Locker of using added fibrous material in

with/without the other prior art of record is appropriate based on the suggestion in Locker of using added fibrous material in the barrier layer as an option and whether such optional additive material use would have reasonably been expected to result in a mat layer, as claimed. In this regard, we note that appellant acknowledges that an insulating mat typically includes known prior art "fiber mats" (specification, page 12, lines 8-13).

Pursuant to the provisions of 37 CFR § 41.50(a)(2)(effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), appellant is required to timely respond to any supplemental examiner's answer that may be issued in response to this remand.

CONCLUSION

The decision of the examiner to reject claims 1-3, 7, 8, 12-14 and 19 under 35 U.S.C. § 102(e) as being anticipated by Locker is reversed as are the examiner's rejection under section 103(a). This decision includes a remand to the jurisdiction of the examiner for action consistent with our remarks set forth above pursuant to our authority under 37 CFR § 41.50(a)(1) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)).

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01 (D)(8th ed., Rev. 2, May 2004, p. 700-126). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

REVERSED/REMANDED

CHARLES F. WARREN)
Administrative Patent Judge)
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THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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